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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/843,132 | 04/25/2001 | John P. McKearn | 3167/12 | 8349 |

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| EXAMINER | |
|---|---|
| COOK, REBECCA | |
| **ART UNIT** | **PAPER NUMBER** |
| 1614 | |

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/843,132 | MCKEARN ET AL. | |
| | Examiner | Art Unit | |
| | Rebecca Cook | 1614 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *16 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-139* is/are pending in the application.

4a) Of the above claim(s) *6,13,15-39,52,59,61-85,98,105 and 107-131* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,7-12,14,40-51,53-58,60,86-97,99-104,106 and 132-139* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *3/16/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

Support is seen in 09/470,951, filed 12/22/99 for the method of using a COX-2 inhibitor to treat a neoplasia disorder. However, no support is seen in '951 for a method of using a DNA topoisomerase I inhibiting agent.

### Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5, 7-12, 14, 40-51, 53-58, 60, 86-92 and 132-139 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/25896 and applicants' disclosure on page 43 of the DNA topoisomerase I inhibiting agent camptothecin (taught in WO 96/37496, 1966).

WO 98/25896 discloses that COX-2 inhibitors, including celecoxib, are useful to treat cancer (page 3, line 19).

WO 96/37496 discloses that camptothecin is useful to treat cancer (applicants' disclosure, page 43, Table No. 3)

Furthermore, "[i]t is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose...[T]he idea of combining them flows logically from their having been individually taught in the prior art." *In re Kerkhoven* 105 USPQ 1069. Therefore, in the absence of a showing of unexpected results, it would be

obvious to one of ordinary skill to combine celecoxib and camptothecin to yield the instant method and composition, since each is individually taught in the prior art to be useful to treat cancer.

**Earlier Rejections**

In view of applicants' amendments the earlier rejections under 35 USC 112, paragraphs one and two and under 35 USC 101 are overcome.

In view of the unexpected results disclosed in Trifan that celecoxib reduces the severity of diarrhea caused by irinotecan, the rejection under 35 USC 103(a) to WO 98/25896 and WO 98/25896 is overcome. Claims drawn to the instant method limited to elected combination of celecoxib and irinotecan or its salt irinotecan hydrochloride would be allowable.

**Double Patenting**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5, 7-12,14, 40-51, 53-58, 60, 86-92 and 132-139 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable

over claims 1-15, 18, 20-22 of U.S. Patent No. 6,649,645. Although the conflicting claims are not identical, they are not patentably distinct from each other because the "comprising" language of '645 would include a method of treating a neoplasm using the instant irinotecan and the instant claims do not exclude a method of treating neoplasm using the radiation of '645. It is well-known to use combination therapy in treating neoplasms.

Claims 1-5, 7-12,14, 40-51, 53-58, 60, 86-92 and 132-139 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,469,040. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of '040 of treating a neoplasm using a COX-2 inhibitor and a chemotherapeutic agent renders the instant method obvious. It is well-known to use combination therapy in treating neoplasms. The "comprising" language of '261 does not exclude the instant irinotecan.

Claims 1-5, 7-12,14, 40-51, 53-58, 60, 86-92 and 132-139 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 5,972,986. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of '986 of treating a neoplasm using a COX-2 inhibitor and a chemotherapeutic agent renders the instant method obvious. It is well-known to use combination therapy in treating neoplasms. The "comprising" language of '986 does not exclude the instant irinotecan.

Claims 1-5,7-12,14,40-51,53-58,60,86-92 and 132-139 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being

unpatentable over claims 1-4 of copending Application No. 09/385,214. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of '214 of treating a neoplasm using a COX-2 inhibitor and radiation renders the instant method obvious. It is well-known to use combination therapy in treating neoplasms.

Claims 1-5, 7-12,14, 40-51, 53-58, 60, 86-92 and 132-139 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 16 of copending Application No. 09/461,953. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of '953 of treating a neoplasm using a COX-2 inhibitor renders the instant method obvious. The "comprising" language of '953 does not exclude the instant irinotecan.

Claims 1-5, 7-12,14, 40-51, 53-58, 60, 86-92 and 132-139 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 09/862,128. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of '128 of treating a neoplasm using a COX-2 inhibitor and a chemotherapeutic agent renders the instant method obvious. It is well-known to use combination therapy in treating neoplasms.

Claims 1-5, 7-12,14, 40-51, 53-58, 60, 86-92 and 132-139 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 42-43 of copending Application No. 09/868,063.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of '063 of treating a neoplasm using a COX-2 inhibitor and a chemotherapeutic agent renders the instant method obvious. It is well-known to use combination therapy in treating neoplasms.

Claim 1-5,7-12,14,40-51,53-58,60,86-92 and 132-139 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 141, 144-174 of copending Application No. 09/868,261. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of '261 of treating a neoplasm using a COX-2 inhibitor and a chemotherapeutic agent renders the instant method obvious. It is well-known to use combination therapy in treating neoplasms. The instant "comprising" language does not exclude the integrin compounds of '261. The "comprising" language of '261 does not exclude the instant irinotecan.

Claims 1-5,7-12,14,40-51,53-58,60,86-92 and 132-139 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-309 of copending Application No. 10/135,793. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of '793 of treating a neoplasm using a COX-2 inhibitor and a chemotherapeutic agent renders the instant method obvious. It is well-known to use combination therapy in treating neoplasms.

Claims 1-5,7-12,14,40-51,53-58,60,86-92 and 132-139 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being

unpatentable over claims 1-85 of copending Application No. 10/150,546. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of '546 of treating a neoplasm using a COX-2 inhibitor and a chemotherapeutic agent renders the instant method obvious. It is well-known to use combination therapy in treating neoplasms.

Claims 1-5, 7-12,14, 40-51, 53-58, 60, 86-92 and 132-139 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21-25 of copending Application No. 10/226,247. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of '247 of treating a neoplasm using a COX-2 inhibitor and a chemotherapeutic agent renders the instant method obvious. It is well-known to use combination therapy in treating neoplasms.

Claims 1-5, 7-12,14, 40-51, 53-58, 60, 86-92 and 132-139 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of copending Application No. 10/212,523. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of '523 of treating a neoplasm using a COX-2 inhibitor and a chemotherapeutic agent renders the instant method obvious. It is well-known to use combination therapy in treating neoplasms.

Claims 1-5,7-12,14,40-51,53-58,60,86-92 and 132-139 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-49 of copending Application No. 10/218,910. Although the

conflicting claims are not identical, they are not patentably distinct from each other because the method of '910 of treating a neoplasm using a COX-2 inhibitor and a chemotherapeutic agent renders the instant method obvious. It is well-known to use combination therapy in treating neoplasms.

Claims 1-5,7-12,14,40-51,53-58,60,86-92 and 132-139 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 21-25 of copending Application No. 10/226,247. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of '247 of treating a neoplasm using a COX-2 inhibitor and a chemotherapeutic agent renders the instant method obvious. It is well-known to use combination therapy in treating neoplasms.

Claims 1-5,7-12,14,40-51,53-58,60,86-92 and 132-139 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-46 of copending Application No. 10/323,065. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of '065 of treating a neoplasm using a COX-2 inhibitor and a chemotherapeutic agent renders the instant method obvious. It is well-known to use combination therapy in treating neoplasms.

Claims 1-5,7-12,14,40-51,53-58,60,86-92 and 132-139 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-120 of copending Application No. 10/366,739. Although the conflicting claims are not identical, they are not patentably distinct from each other

because the method of '739 of treating a neoplasm using a COX-2 inhibitor and a chemotherapeutic agent renders the instant method obvious. It is well-known to use combination therapy in treating neoplasms.

Claims 1-5,7-12,14,40-51,53-58,60,86-92 and 132-139 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-46 of copending Application No. 10/414,867. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of '867 of treating a neoplasm using a COX-2 inhibitor and a chemotherapeutic agent renders the instant method obvious. It is well-known to use combination therapy in treating neoplasms.

Claims 1-5, 7-12,14, 40-51, 53-58, 60, 86-92 and 132-139 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of copending Application No. 10/421,685. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of '685 of treating a neoplasm using a COX-2 inhibitor and a chemotherapeutic agent renders the instant method obvious. It is well-known to use combination therapy in treating neoplasms. The "comprising" language of '685 does not exclude the instant irinotecan.

Claims 1-5,7-12,14,40-51,53-58,60,86-92 and 132-139 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-49 of copending Application No. 10/423,526. Although the conflicting claims are not identical, they are not patentably distinct from each other

because the method of '182 of treating a neoplasm using a COX-2 inhibitor and a chemotherapeutic agent renders the instant method obvious. It is well-known to use combination therapy in treating neoplasms. The "comprising" language of '261 does not exclude the instant irinotecan.

Claims 1-5,7-12,14,40-51,53-58,60,86-92 and 132-139 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 10/424,182. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of '866 of treating a neoplasm using a COX-2 inhibitor and a chemotherapeutic agent renders the instant method obvious. It is well-known to use combination therapy in treating neoplasms. The "comprising" language of '866 does not exclude the instant irinotecan.

Claims 1-5, 7-12,14, 40-51, 53-58, 60, 86-97, 92 and 132-139 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of copending Application No. 10/445,823. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of '823 of treating a neoplasm using a COX-2 inhibitor and a chemotherapeutic agent renders the instant method obvious. It is well-known to use combination therapy in treating neoplasms. The "comprising" language of '261 does not exclude the instant irinotecan.

Claims 1-5, 7-12,14, 40-51, 53-58, 60, 86-92 and 132-139 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as

being unpatentable over claims 1-4 of copending Application No. 10/461,983. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of '983 of treating a neoplasm using a COX-2 inhibitor and a chemotherapeutic agent renders the instant method obvious. It is well-known to use combination therapy in treating neoplasms. The "comprising" language of '182 does not exclude the instant irinotecan. The instant "comprising" language does not exclude the radiation of '983.

Claims 1-5,7-12,14,40-51,53-58,60,86-92 and 132-139 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-34 of copending Application No. 10/651,916. Although the conflicting claims are not identical, they are not patentably distinct from each other because the method of '182 of treating a neoplasm using a COX-2 inhibitor and a chemotherapeutic agent renders the instant method obvious. It is well-known to use combination therapy in treating neoplasms. The "comprising" language of '916 does not exclude the instant irinotecan.

These are provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicants are requested to identify any additional applications and patents in which there may be double patenting.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Cook whose telephone number is (571) 272-0571. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Low, can be reached on (571) 272-0951.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Renee Jones (571) 272-0547 in Customer Service.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The official fax number is 703-872-9806

Rebecca Cook

Primary Examiner
Art Unit 1614

July 10, 2004